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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

PETER AR-FU LAM

Serial No. 09/930,422

Filed: 12/22/2009

For: Body Profile Coding Method
And Apparatus Useful For
Assisting Users To Select
Wearing ApparelHon. Commissioner of Patents
and TrademarksExaminer:
Buchanan, Christopher R

Group: 3627

Docket: BPCODE 2

February 19, 2010

Sir,

Petition to Director – according to 37 CFR 1.181 (a) 1

This petition comprises of two sections (A) and (B) respectively. In response to the office communications dated 12/22/2009 and various previous communications between the applicant and the examination office, please consider the facts submitted and grant the relief requested by the applicant as follow.

(A) Adequate information about ground of rejection:Statement of facts

1. In various previous communications between the applicant and the examination office, the applicant had respectfully requested (the "First Request") the office action to "clearly" identify how the claimed limitations had been disclosed in the cited prior art Spackova, US Patent 4,539,585.

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The information is required for the applicant to compose a proper response for overcoming a rejection of independent claim 40 under 35 U.S.C. 103(a).

2. Listed below is a quotation of precedent court ruling **Graham v. John Deere Co.**, 383 U.S. 1, 148 USPQ 459 (1966) – herein abbreviated as the “Graham inquiry”:

Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (a) Determine the scope and content of the prior art; and*
- (b) Ascertaining the differences between the claimed invention and the prior art; and*
- (c) Resolving the level of ordinary skill in the pertinent art for the obvious combination or modification.*
- (d) Evaluate other objective evidence and secondary considerations relevant to the issue of obviousness*

Graham inquiry set forth the examination process required to determine if an invention is obvious as compared with a prior art. The ground to support applicant's First Request was firstly based on step (b) of the Graham inquiry.

3. Applicant's Request was then based on the quotation of 37 CFR 1.104(b) and MPEP 707.07:

*Completeness and clarity of examiner's action.
The examiner's action will be complete as to ALL matters.*

According to 37 CFR 1.104(b) and MPEP 707.07, it is the right of the applicant to demand clear explanation how **EVERY** claim limitation, one by one is interpreted, and how the corresponding claim interpretation is exactly found in the figure and element numbers of the drawings, or located in the wording description in column and line numbers of the prior art specification.

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4. Applicant's First Request was further based on the following views of the patent rules:

(a) MPEP 2111.01 I - Plain Meaning [R-5]

I.THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS **>SUCH MEANING IS INCONSISTENT WITH< THE SPECIFICATION

In re American Academy of Science Tech Center, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)

(b) MPEP 2111.01 III – Plain Meaning

III.< "PLAIN MEANING" REFERS TO THE ORDINARY AND CUSTOMARY MEAN-ING GIVEN TO THE TERM BY THOSE OF ORDINARY SKILL IN THE ART

*Phillips v. AWH Corp., *>415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (en banc). Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)*

(c) MPEP 2112.02 - Process Claims

PROCESS CLAIMS — PRIOR ART DEVICE ANTICIPATES A CLAIMED PROCESS IF THE DEVICE CARRIES OUT THE PROCESS DURING NORMAL OPERATION

The above quotations, although are not the subject matter of the subject petition, are in fact related to the guideline to determine if the previous office actions had properly and adequately complied with the requirements set forth by the Graham inquiry, **37 CFR 1.104(b)** and **MPEP 707.07** herein.

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5. Listed below is the recitation of pending independent claim 40:

40. A method of processing a body profile (BP) code describing the physical dimensions of a human body to facilitate garment shopping, said method comprising the steps of:

- (1) specifying the positions of the body to be measured for defining m different physical dimensional parameters of said human body;
- (2) measuring in length unit each of said m defined parameters a physical dimension of said body to produce m values; and
- (3) processing said m values to produce a multiple digits compressed BP code for representing said m values.

The limitations recited by claim 40 are outlined as follow:

- (a) a step to define m different physical dimensional parameters of a human body and a step to specify the position of the body to be measured for each of the defined physical dimensional parameter. In a preferred embodiment of the specification, the physical dimensional parameters of a claimed BP Code are defined to be "Arm Length", "Neck Diameter", "Torso length", "Waist Diameter" and "Leg Length" respectively.
 - (b) a process to measure each of said m defined parameters to produce a value expressed in "length unit". The length unit of the physical dimensional parameters of the preferred embodiment are expressed in unit of inches.
 - (c) a process to "process" said m values to produce a "multiple digits" "compressed" BP code for representing said m values.
6. The applicant had repeatedly requested the office action to clarify how the following claim limitations are interpreted and found in the prima facie prior art Spackova?

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- (i) Precisely point out **“what are the m different physical dimensional parameters”** interpreted in Spackova and **“where”** these interpreted parameters are exactly located in the disclosure of Spackova?
 - (ii) Indicate where in the disclosure of Spackova, describing how these physical dimensional parameters are reasonably required in the normal operation process of Spackova (MPEP 2112.02 requirement)?
 - (iii) Indicate where in the disclosure of Spackova, describing **“how”** these “physical dimensional parameters in length units” are “measured” in the normal operation of Spackova;
 - (iv) Point out **“where”** in the disclosure of Spackova, describing the m measured values claimed can be obtained from the normal operation of the device of Speckova (MPEP 2112.02 requirement)?
7. So far all the previous office actions had failed to provide clarification to the claim limitations of sections (A)(5) and (A)(6) set forth above as required by the Graham inquiry, **37 CFR 1.104(b)** and **MPEP 707.07** herein. Upon repeated requests submitted by the applicant, the office actions dated 07/30/2009 and 12/22/2009 had declined the request with “verbatim matching” as a reason. On page 9, first paragraph of the office action dated 07/30/2009 and page 7, last paragraph of the office action dated 12/22/2009, these office actions recited that:

Applicant apparently wants a one-to-one, verbatim matching between the instant claims and the prior art. However, this is not possible due to differences in terminology, the nature of the rejection (which combines teachings from multiple references in this case), and actual differences in the inventions themselves. No amount of explanation or comparison can overcome a difference of opinion held between the examiner and applicant regarding the interpretation of what is being claimed and what is disclosed by the prior art.

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The above explicit recitation of the office action concludes the inability for the office action to provide clear interpretation of claim limitations, to precisely locate these interpretations in the cited prior art and to provide one-by-one prior art comparison because:

- (a) a one-to-one verbatim matching between the instant claims and the prior art is improper;
- (b) Clear limitation comparison is impossible due to differences in terminology;
- (c) Clear limitation comparison is impossible because multiple references are combined to provide the ground of rejection;
- (d) Clear limitation comparison is impossible due to differences in the inventions themselves; and
- (e) No amount of explanation or comparison can overcome a difference of opinion held between the examiner and applicant regarding of what is being claimed and what is disclosed by the prior art.

8. In applicant's response dated 10/30/2009, the applicant had respectfully objected the "verbatim matching" as a reason to decline the requirement of patent rules to clarify how each claim limitation is interpreted and found in the cited prior art.

For reason (a), one-to-one verbatim matching between the instant claims and the prior art is **"one of the many acceptable forms"** to conduct the first two steps of the Graham inquiry. If one-to-one verbatim matching is not possible, the applicant can accept "any other alternate ways" that is able to clearly identify how each claim limitation is precisely located in the disclosure of the prior art. For example, it is acceptable for the examiner to provide alternate wording pointing out that the belt of the figure without the indicia in FIG. 3 is the first physical dimensional parameter, and the distance between the indicia 72 and 74 is the second physical dimensional

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parameter, in order to meet the claim limitation of m physical dimensional parameters.

For reason (b), the office action erred in holding a position that differences in terminology disable the ability for an office action to provide clear comparison for each claim limitation. The applicant can accept different terminology as long as the office action clearly indicates how each terminology of the prior art is equated to a term used in a claim. For example, the applicant can accept the statement that "the eye glass 21 of FIG. is equivalent to the first parameter recited and the indicia 74 is equivalent to the second parameter recited. Cross matching of different terminology is acceptable as long as they are clearly expressed in the office action.

For reason (c), the examiner had been respectfully requested to note that the Graham inquiry emphasized by the Supreme Court requires clear claim limitation comparison with each prior art, before the prior arts are evaluated if their further combinations are obvious. Therefore the situation of reason (c) does not exist in the early steps of the Graham inquiry which compare the claim limitation only with the prima facie prior art. It is also important to note that if explicit one-to-one comparisons of claim limitations are not conducted, the early step (b) of the Graham inquiry cannot be completed.

For reason (d), the office action explicitly acknowledged that clear comparison for each claim limitation is impossible due to differences in the invention themselves. In fact this is exactly the key factor to determine if a claim is obvious when compared with a prior art. The Graham inquiry specifically requires the office action to compare the claim limitation of an invention with the disclosure of a cited prior art. The patent rules does **NOT** provide provision declining the right of an applicant to know the exact

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ground how each claim limitation is interpreted and found in a prior art because the two inventions are too different to be compared.

For reason (e), the office action erred to indicate that clear explanation and claim limitation comparison is impossible due to difference in opinion between the examiner and the applicant. The requirement to provide clear claim limitation comparison is a matter of law and not a matter of opinion. The difference in opinions is to be resolved by law. The patent rules and examination process of our country is very mature and complete. In this case, if terms of claim limitations are interpreted according to MPEP 2111.01, MPEP 2111.01 III and MPEP 2112.02 as recited herein; the differences between claim limitations and the prior art are compared as directed by the Graham inquiry, and the comparison results are completely expressed in an office action according to 37 CFR 1.104(b), MPEP 707.07, the applicant does not see any reason why the above examination process cannot be carried out for the subject application. Any difference in opinion is to be resolved with recitation of proper supporting law, MPEP and precedent court ruling. If one party feels that the quotation of law, MPEP and precedent court ruling provided by another party is improper, the party should clearly providing reasons informing the other party why the law supported reasons quoted was wrong.

9. Listed below is a quotation of MPEP 707.07(f):

707.07(f) Answer All Material Traversed[R-3]

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

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Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

The office action dated 12/22/2009 failed to provide any answer to applicant's argument of section (A)(7) and (A)(8) above. Although this point is not the subject matter of the petition, this is to demonstrate the great difficulty being faced by applicant, for him to compose a proper argument without an examination process following the requirement of patent rules and MPEP.

10. This section of the petition is directed only to subject matter about the clarity of an office action for the limitation by limitation comparison between the subject claims and the cited prior art, so as for the applicant to draft a proper response. Since the applicant is still in a position awaiting to clearly understand how each claim limitation is interpreted and found in the cited prior art so as to draft a proper reply, the subject matter of this section of the petition does not include any issue that is subject to appeal.

Points to be reviewed

1. With this petition, the applicant respectfully requested a review if it is proper for the applicant to insist his right for the terms of claim 40 to be interpreted according to MPEP 2111.01, MPEP 2111.01 III and MPEP 2112.02 as recited herein for constructing the claim limitations, then for the differences between constructed claim limitations and the prior art to be compared as directed by the Graham inquiry, and then the comparison process, reasons and results to be comprehensively expressed in an office action according to 37 CFR 1.104(b), MPEP 707.07.

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2. The applicant further respectfully requests a review if "one to one verbatim matching", is supported by patent rules to be used as a reason to prohibit the above right of the applicant to understand the clear ground of rejection, how one to one claim limitations are interpreted and located in the cited prior art, so as to prepare a proper response.

Action requested

1. The applicant respectfully requests an office action that honors the right of the applicant to have the terms of claim 40 to be interpreted according to MPEP 2111.01, MPEP 2111.01 III and MPEP 2112.02 as recited herein for constructing the claim limitations, then for the differences between constructed claim limitations and the prior art to be compared as directed by the Graham inquiry, and then the comparison process, reasons and results to be comprehensively expressed in an office action, clarifying and answering all the ambiguous area raised by the applicant in accordance to 37 CFR 1.104(b) and MPEP 707.07.
2. The applicant further respectfully requests "one to one verbatim matching" to be withdrawn as a reason to forfeit his right to clearly understand how one to one claim limitations are interpreted and located in the cited prior art, so as for the applicant to prepare a proper response.
3. This petition comprises of two sections (A) and (B) respectively, and each section may comprise more than one issue to be reviewed. If after the review, an issue is to be declined while some other issue(s) is ruled in favor of the applicant, it is respectfully requested that the term "rejected" **NOT** to be used in the response of the petition. This is because the applicant had experienced the failure for an examiner to response to the portion of the review in favor of the applicant simply because the petition was concluded as rejected. Any legal term such as "affirm in part and

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vacate/remand in part" or it's equivalent is respectfully requested to be used for describing the result of such situation.

(B) Request of supporting prior art or an affidavit under 37 C.F.R. 1.107(b) about the level of skill to take an office notice stated in lieu of a supporting prior art.

Statement of facts

1. This section of petition is related to the supply of adequate information to support rejection of claims 7, 9-18, 49 and 52.
2. The applicant's respectfully submitted that he was unaware of any BP Code previously available in the field before the subject invention that can be decompressed to retrieve the user body measurements. The applicant was also unaware of any well-known application example of the use of n1+n2 codes claimed as alleged by the office action for rejecting claims 6, 7, 9-18 and 49. The applicant particularly wishes to pint out that the technology of n1+n2 codes towards body size measurements is not an ordinary technology to be well known to a person having ordinary skill in the art of garment industry.

Listed below is a quotation of a precedent court case *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993),

Finally, appellants seemingly argue that the examiner's lack of citation to support the asserted level of skill in the art makes the rejections improper per se. This is so, appellants suggest, because without such citation, there is no record by which they can argue that the examiner erred.

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The following is a quotation from 37 C.F.R. 1.107(b):

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

The examiner had previously been respectfully directed to page 3, second to fifth paragraph of applicant's response dated 05/17/2006 and section (D), page 17 of applicant's response dated 05/05/2009, which requested the office action to provide cited reference to support the ground of rejection of the subject claims, or to provide an affidavit under 37 C.F.R. 1.107(b) in lieu of the cited reference, providing citation regarding level of skill required by a person having ordinary knowledge in the art of garment industry to acquire the knowledge of the claimed limitation.

3. In response to applicant's request on 05/17/2006, the office action cited Runton as a prior art to support the corresponding ground of rejection.
4. The response of the applicant dated 06/20/2007 provided evidence to demonstrate why the teaching of Runton failed to teach the limitation claimed.
5. The subsequent office action dated 09/25/2007 exchanged Runton with another prior art Powell to support the corresponding ground of rejection.
6. In a telephone dated 10/30/2007, the examiner agreed that Powell failed to teach the subject rejection. The office action dated 01/07/2008 exchanged Powell one more time with another prior art Aisaka to support the corresponding ground of rejection.

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7. Applicant's response dated 05/05/2008 submitted evidence to prove that Aisaka failed to teach the corresponding claim limitations.
8. The office action dated 12/16/2008 and applicant's response dated 04/15/2009 exchanged further opinions if Aisaka is a proper reference to support the process of compress and decompress human body measurements. Eventually the latest office action dated 07/30/2009 the office action provided the following recitation on page 5, last paragraph:

The examiner further gives official notice that the feature of a compressed body profile code is well-known and commonly used in the art.

The office action dated 07/30/2009, page 6 further recited that:

Regarding claim 52, since the m values are being compressed to produce a BP code by some process, it would be a matter of logic that a similar process could be used to decompress the code to provide the original input quantities. This process is merely arrives at the starting point of having m values, thus does not provide any useful result. The examiner further gives official notice that data compression, decompression and manipulation are well-known in the art.

It means after failing to utilize Runton, then Powell, then Aisaka as prior art to support the ground of rejection, the office action returned to the original point of 05/17/2006, using an official notice to support the ground of rejection. Although the applicant had repeatedly quoted precedent court case *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993) and 37 C.F.R. 1.107(b) requesting another supporting prior art citation or an affidavit under 37 C.F.R. 1.107(b), this time the office action simply declined the request.

8. At the bottom of page 8, the office action dated 12/22/2009 indicated a proper response to rejection made using official notice or design choice

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required the applicant to submit reasoned arguments that explain how the rejection is invalid and describe the novelty of, purpose of, and problems solved by the invention along with evidence supporting these arguments. The office action did not state which part of the patent rules, law or MPEP set forth these additional requirements to traverse a ground of rejection not supported by a proper prior art. In the contrast applicant's request of proper cited prior art was well supported by 37 C.F.R. 1.107(b) and a precedent court ruling *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993).

9. Even if the future office action is able to quote supporting patent rule to justify the new requirement stated in the office action dated 12/22/2009, according to the prosecution history of the subject application, the failure of previous office actions to utilize Runton, then Powell, and then Aisaka one by one as prior art to support the ground of rejection had already become a strong evidence that a proper reference prior art is needed for the applicant to draft a proper argument to overcome the ground of rejection. The novelty, purpose and problems solved by the invention had long been well described in great detail in the original specification of the subject invention, to provide a portable compressed BP Code that enables purchasing a fitted garment for a remote friend/relative and to reduce return of online garment shopping. The comprehensive decoded data of the BP Code reflects the detail body measurement of a user and provides better fitting service than standard garment size charts available in the market. These are obvious evidences of the advantages of the subject invention. It means the further information and evidences asked by the office action dated 12/22/2009 had already been supplied to the examiner long time ago.
10. It is unfair to the applicant for the present office action not to follow the repeated request made according to 37 C.F.R. 1.107(b), which had one

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time been honored but later failed to support the ground of rejection after three rounds of different prior art citations failed to proof that the claimed limitations are obvious.

11. This section of the petition is directed only to subject matter about the request of information made under 37 C.F.R. 1.107(b) and precedent court ruling *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993) so as to allow the applicant to properly draft a response. Since the applicant is still in a position awaiting to evaluate the cited prior art requested under patent rules so as to draft a proper reply, the subject matter of this section of the petition does not include any issue that is subject to appeal.

Points to be reviewed

1. Did 37 C.F.R. 1.107(b) and precedent court ruling *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993) gave the applicant the right to ask for a forth round of cited prior art, after the first three rounds were successfully traversed; or an affidavit by the examiner in lieu of the required cited prior art?

Action requested

1. Request the examiner to provide a fourth round of supporting prior art or an affidavit under 37 C.F.R. 1.107(b) in lieu of a cited prior art reference.
2. This petition comprises of two sections (A) and (B) respectively, and each section may comprise more than one issue to be reviewed. If after the review, an issue is to be declined while one or more other issue(s) is ruled in favor of the applicant, it is respectfully requested that the term "rejected" **NOT** to be used in the response of the petition. This is because the applicant had experienced the failure for an examiner to response to the portion of the review in favor of the applicant simply because the petition was concluded as rejected. Any legal term such as "affirm in part and

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vacate/remand in part" or it's equivalent is respectfully requested to be used for describing the result of such situation.

(C) Other remarks:

Reconsideration requests and repeated actions of the examiner

Request of reconsideration of the subject matter of this petition had been submitted in previous response of the applicant and the reconsideration request had not been honored in the latest office action.

Petition Fee

Patent fee if required is provided by enclosed credit card payment.

Timely filing of the petition

This petition is timely filed within two months from 12/22/2009, the mailing date of the latest office communication.

Nature of the petition

The petition is related to two procedural matters of the subject patent application.

Respectfully submitted,



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